

204720US-2



#5/Election
8.27.02
C. Moore

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

TATSUYA KUNIKIYO

: EXAMINER: BETTENDORF, J. P.

SERIAL NO.: 09/805,925

FILED: March 15, 2001

: GROUP ART UNIT: 2817

FOR: ACTIVE INDUCTOR

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RESPONSE TO ELECTION OF SPECIES REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Election of Species Requirement dated July 16, 2002, Applicant provisionally elects with traverse Species I, depicted in Figures 1 and 8, and identifies Claims 1, 6, and 11 as readable on the elected species.

Applicant respectfully traverses the election requirement for several reasons.

First, the outstanding Official Action fails to state any basis whatsoever in support of the restriction requirement. This violates MPEP § 816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires: "Claims to be restricted to different species must

be mutually exclusive” The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics, and this failure provides a further basis for traversing the election requirement.


Finally, MPEP § 803 states: “If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The Claims of Species I-III appear to be part of an overlapping search area. Therefore, Applicant traverses the outstanding Election of Species Requirement on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner.

Accordingly, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 1-15 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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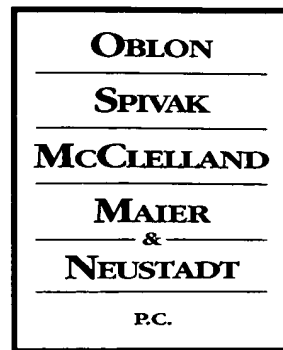
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ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231



RE: Application Serial No.: 09/805,925
Applicants: Tatsuya Kunikiyo
Filing Date: March 15, 2001
For: ACTIVE INDUCTOR
Group Art Unit: 2817
Examiner: BETTENDORF, J. P.

ATTORNEYS AT LAW

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SIR:

Attached hereto for filing are the following papers:

Response to Election of Species Requirement

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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